

VIA EFS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of :
Olaseni B. Duro-Emanuel *et. al.* :
Conf. No.: 6554 : Group Art Unit: 3696
Appln. No.: 10/645,060 : Examiner: William E. Rankins
Filing Date: August 21, 2003 : Attorney Docket No.: 101612-5026US
Title: TERM NOTE PAIRED WITH A MONEY MARKET NOTE

APPELLANTS' REPLY TO EXAMINER'S ANSWER

Appellants hereby Reply to the Examiner's Answer mailed April 28, 2011.

It is not believed that any fee is due herewith, but the Director is hereby authorized to charge any required fees to Deposit Account No. **50-0310** (Billing No. 101612-5026).

The Examiner first comments on the Appellants' reliance on MPEP 2163.02, to support the notion that the subject matter of the claims need not be described literally in order for the disclosure to satisfy the written description requirement. In particular, the Examiner states that the Appellants have "not fully considered the guidelines under MPEP 2163.02" because the Appellants have not cited to the portion of the MPEP section stating that "[i]f a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C. 112, 1st paragraph – description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate." Appellants have, indeed, considered both provisions of MPEP 2163.02, which are presented in the same paragraph thereof. Appellants submit that both provisions need to be read together such that, in determining whether subject matter, limitations, or terminology is present in the application as filed, the subject matter need not be described literally (i.e., using the same terms or in haec verba). It is respectfully submitted that the Examiner has not fully considered MPEP 2163.02 in his analysis.

The Examiner then refers to several MPEP sections, namely 2161.02, 2163.02, and 2163.03, reciting various tests and determinations relating to when the written description requirement is met. However, other than some general statements to the effect that "neither computer hardware nor software is disclosed in the specification as originally filed", the Examiner fails to apply the cited MPEP sections to the specific circumstances of the matter at hand. The Examiner further states, at the top of page 9 of the Answer, that "applicant has not pointed out where the limitation is supported." Appellants respectfully disagree. Indeed, the

Appellants have cited to various sections in the specification in support of the claim limitations at issue. The Examiner's disagreement with the Appellants on this point is described below.

In their Brief, the Appellants cited to support in the specification for the notion that collections may be represented electronically. The Examiner states "that the term collection is not used in the claims and therefore this section of the specification does not apply to the rejection at issue" and, further, that "the act of receiving a payment is not a step in the process." Appellants agree that the term "collection" is not used in the claims, although and that "receiving a payment" is not a positively recited step in claim 35 (claim 35 is a system claim). However, the fact that a *payment* (a claim limitation), received as a *collection*, is performed electronically, which payment is ultimately *credited* electronically (as set forth in the claims), is highly relevant in terms of what the specification would convey to one skilled in the art. As stated in MPEP 2163.02, cited by the Examiner: "An applicant shows possession of the claimed invention by *describing the claimed invention with all of its limitations* using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." Thus, the specification's disclosure of collections/payments being represented electronically provides support for the claim limitations at issue.

The Appellants further cited to support in the specification for the notion that crediting may be performed electronically. The Examiner states that "[the collection and crediting] steps are not necessarily performed exclusively by a machine" and "[t]here may be significant human involvement in the process steps and the specification leaves that inquiry unresolved." Appellants are aware of no requirement that a specification must resolve all matters of alternative, hypothetical implementation of an invention. The standard for determining compliance with the written description requirement is whether one skilled in the art would

understand that the applicants were in possession of the invention (see MPEP 2163.01), not whether the specification describes alternative manners of implementation that are not claimed.

The Appellants further cited to support in the specification for the notion that the financial instruments recited in the claims can be embodied in electronic form. The Examiner again states that this has no bearing on the claims at issue “because their [sic] is no specific limitation in the claims regarding how the notes may be represented.” Appellants disagree – the claims recite a money market note and a term note. The fact that these notes are embodied in electronic form is further supportive of the notion that the claimed functionality carried out with regard to such notes is carried out by a computer. The Examiner further states that “this section of the specification may be referring to dematerialized securities which are simply an electronic representation of a security which makes tangible certificates unnecessary.” Such statement is purely speculative and, in any event, does not detract from the fact that the notes are represented electronically (regardless of the reason why), thereby requiring computers to carry out functionality pertaining to them.

In summary, the specification provides specific support for electronic representation of the notes themselves, electronic payments on the notes, and electronic crediting the received payments (i.e., the recited functionality for how liquidity is provided to the transaction). In view of this, one skilled in the art clearly would understand the inventors to be in possession of the claimed invention at the time the application was filed.

The Examiner’s final comment notes that “because certain actions, namely collecting, crediting and representation of securities can be performed electronically does not lead to the necessity for a system comprising memory, a processor and computer readable instructions to perform the steps of providing liquidity to a financial transaction by determining if a note is fully

credited and if so redirecting the payment.” Applicants submit that any computer that performs the actions of collecting, crediting and representing securities electronically *would* necessarily include a memory to store data and computer readable instructions, a processor to carry out functionality, and computer readable instructions that specify the functionality that is to be carried out. A computer without a memory, a processor and computer readable instructions is, essentially, a shell and not capable of functioning. Still further, the Examiner states that “[t]he applicant argues that their interpretation of the originally filed disclosure would be obvious to one of ordinary skill in the art” which “is not the test.” Appellants respectfully note that nowhere in their Brief do they state that obviousness is that standard.

In view of the foregoing, Appellants respectfully submit that the rejections made in the Final Office Action dated October 27, 2010 are in error and therefore should be withdrawn.

Respectfully submitted,
MORGAN, LEWIS & BOCKIUS LLP

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